

MAIL STOP AF  
PATENT  
3003-1130-1

**IN THE U.S. PATENT AND TRADEMARK OFFICE**

In re application of

Kevin J. HERBERT et al.

Conf. 4238

Application No. 10/586,485

Group 3766

Filed August 21, 2006

Examiner J. Kimball

A DEFIBRILLATOR DEVICE WITH A REMOTE REGION ON ITS CASING

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Assistant Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
Sir:

April 5, 2010

Applicants request a pre-appeal brief review of the final rejection in the above-identified application. No amendments are being filed with this request.

A Notice of Appeal is filed herewith.

The review is requested for the reasons advanced on the attached sheets.

Respectfully submitted,

YOUNG & THOMPSON

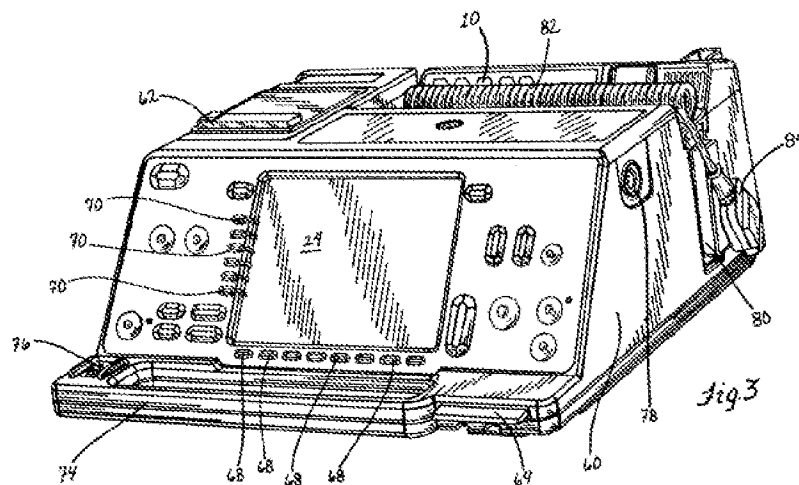
/Roland E. Long, Jr./  
Roland E. Long, Jr., Reg. No. 41,949  
209 Madison Street Suite 500  
Alexandria, VA 22314  
Telephone (703) 521-2297  
Telefax (703) 685-0573  
(703) 979-4709

REL/jaa

**REASONS IN SUPPORT OF REQUEST FOR REVIEW**

Applicant requests a pre-appeal brief review of the below-identified final claim rejections, the rejection being based on a legal or factual error.

I. Claims 1 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Skelton 6,292,692.



Skelton Figure 3 appears above. The rejection states that Skelton discloses a defibrillator device 10 comprising a casing 60 having a carrying handle 74 and further containing electrical circuitry (module 12, Figure 1) ..., a control system (20) ... , and **a detector means (76) to change the operational status of the defibrillator** .

Element 76 is a unit "on/off" switch control incorporated in the handle (column 9, lines 45-48).

The rejection acknowledges that Skelton only teaches a conventional on/off switch and that there is no

teaching or suggestion of the switch 76 being responsive to the handle being grabbed by the operator.

The rejection states that "automatic activation upon grabbing the device for treatment would have been obvious ... as it has been held that broadly providing a mechanical or automatic means to replace a manual activity which has accomplished the same result involves only routine skill in the art. In re Venner, 120 USPQ 199. In addition, it would have been obvious to make activation automatic upon grabbing the device for treatment as emergency situations regarding external defibrillation must be carried out within a very short amount of time in order to save the patient's life and the AED art is always very concerned about providing treatment in as little time as possible, primarily thru automating various functions of the AED (an additional example being Hansen US 20030120311, disclosed within Applicant's specification on Pg. 3)."

This argument has two parts: 1) that only routine skill is required to automate what was previously done manually, and 2) automating various AED functions is known to be desirous.

As to the first part of the argument, that only routine skill is required to automate what was previously done manually, the issue is not whether it was within the skill of the art to achieve the recited feature, but whether it would be obvious to provide that the operational status of the device be changed in use when the handle is grabbed by the operator".

The rejection does not offer any case law for the proposition that it is obvious to automate every manual

activity. Therefore, one cannot show that a claim feature is obvious merely by stating that it would have been within routine skill to automate a previously done manual operation.

As to the first part of the argument, that automating various AED functions is known to be desirous, there is no teaching that automating the startup of an AED in the manner recited was suggested by the AED prior art. Indeed, the AED prior art teaches approaches which are directed to other solutions that are not as effective as the present invention.

Applicant would point out that the AED prior art demonstrates a long-standing need that has not been satisfied and this would indicate that applicant's invention is indeed non-obvious.

The lack of prior art in medical equipment that shows applicant's solution to this problem is strong evidence that applicant's solution is non-obvious.

There is no AED prior art suggesting the operational status of the device be changed in use when the handle is grabbed by the operator. As the rejection urges that implementing such a solution would require only routine skill, the lack of any prior art teaching of the operational status of the device be changed in use when the handle is grabbed by the operator, demonstrates that the feature is indeed non-obvious.

Applicants therefore respectfully request that the rejection of claim 1 be withdrawn.

II. Claims 3-6, 8, 11, 14-16, and 18 were rejected over Skelton in view of Locke 2003/0208237; claims 7, 13,

and 17 in further view of Nova 6,334,070; claims 9, 10, and 12 in still further view of Olsen 5,897,576; claim 19 in view of Medema et al. (US 2004/0124979); and claims 20 in further view of Miller 6,397,104.

These references do not cure the defect in the Skelton rejection discussed as to claim 1.

Indeed, these references teach away from the present invention.

For example, Locke discloses an automatic external defibrillator (AED) which has a housing with a lid which when closed covers at least a portion of the user interface. A dual function on/off button is configured so that, when an operator presses the button, the button causes a switch to close to activate the device and further unlatches the lid.

As with the other prior art, there is no disclosure in Locke of providing a detector means associated with the carrying handle of the device to provide automatic activation upon grabbing the device.

Therefore, as to the claim 1 feature of the operational status of the device being changed in use when the handle is grabbed by the operator, Locke also teaches away from the present invention.

Thus, these other references would out re-inforce that the AED prior art demonstrates a long-standing need that has not been satisfied. This unsatisfied, long-standing need indicates that applicant's invention is indeed non-obvious.

The rejection is in error as there is no factual or legal showing that providing **a detector to change the operational status of a defibrillator to provide automatic activation upon grabbing the device for treatment** is merely "providing a mechanical or automatic means to replace a manual activity which has accomplished the same result".

The rejection is also in error in that there is no factual or legal showing that it would have been obvious to make activation automatic upon grabbing the device since "the AED art is always very concerned about providing treatment in as little time as possible, primarily thru automating various functions of the AED ...."

Applicants therefore again respectfully request that the rejection of claim 1 be withdrawn.